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Xerox Docket No. D/97427

PATENT APPLICATION

**RESPONSE UNDER 37 CFR §1.116
EXPEDITED PROCEDURE**

TECHNOLOGY CENTER ART UNIT 2134

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#34
(N.e.)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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In re the Application of

James D. THORNTON et al.

Application No.: 08/976,579

Filed: November 24, 1997

For: PAPER DOCUMENT SATCHELS

Group Art Unit: 2134 Technology Center 2100

Examiner: C. Brown

Docket No.: JAO 34191

REQUEST FOR RECONSIDERATION AFTER FINAL REJECTION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In reply to the January 15, 2004 Final Office Action, reconsideration of the application is respectfully requested.

Claims 29-37 and 39-45 are pending.

As part of Applicants' response to the merits of the rejection, Applicants address the Examiner's Response to Amendment, found on page 2 of the Office Action, as follows.

With respect to claims 29-37, i.e., the claims in which the preamble recites tokens that point to another document, the Office Action cites a recent Federal Circuit decision which allegedly "indicated that preambles are not necessarily given weight in determining the meaning of claims." Unfortunately, the applicability of the facts of the cited case to the facts, including the claims, of this application is not stated. Absolutely no evidence of the applicability of the cited case to the facts of this application is presented and, without such,

the assertion is irrelevant and immaterial to the issue of whether the preamble of claims 29-37 is to be given patentable weight.

Page 2 of the Office Action also states that, "[B]efore the USPTO, while the claims remain malleable, the appropriate way to change the meaning of the claims is to amend them. While the court is facing fixed claims it must interpret, applicant has had numerous opportunities to actually put the language in the body of the claims."

Applicants respectfully point out that the leading case concerning amending claims before the Office is In re Zletz, 13 USPQ2d 1320 (Fed. Cir. 1989), which indicates that patent applicants have the opportunity to amend their claims during prosecution in order to overcome an indefiniteness rejection. However, there is no indefiniteness rejection of the claims pending in this application. Applicants see no need to amend the claims to change the meaning of the claims.

Moreover, the statements on page 2 of the Office Action do not address the claim language at issue. Because the Office Action does not apply the general statements made on page 2 of the Office Action to the claims, the statements provide no evidence as to the patentable weight to be accorded to the preamble of claims 29-37.

With respect to the assertion that Applicants have not amended the body of the claims, Applicants respectfully disagree. In the Amendment filed July 10, 2003, Applicants amended the preamble and the body of claim 29. The preamble was amended to change "using tokens encoded in a document" to --using tokens encoded in a document to point to another document." The body of claim was amended to change "tokens" to --such tokens--, and "decoded tokens" was amended to recite --such decoded tokens.-- The preamble of claim 32 and the preamble and the body of claim 34 were amended in a similar manner.

Claims 29 and 32 are "system" claims in which the preamble recites "tokens encoded in a document that point to another document." In claim 29, the body expressly refers back to the tokens of the preamble by reciting a decoder that decodes a number of "such tokens" and a selector that lists a number of "such tokens." In claim 32, the body expressly refers back to the tokens of the preamble by reciting a selector means for selecting one or more of the user-selectable tokens. Claims 30-31 depend from claim 29 and contain the positively recited features of claim 29. Claim 33 depends from claim 32 and contains the positively recited features of claim 32. Claim 34 is a method claim in which the preamble recites "using user-selectable tokens encoded in a document that point to another document" and in which the body of the claim expressly refers back to the tokens of the preamble by reciting decoding at least one "such user selectable token." Claim 35 depends from claim 34 and contains all the features of claim 34.

Claim 36 and 37 are system claims in which the body recites tokens that have been embedded in the paper document and that point to another document. The preamble is not at issue in claims 36 and 37.

With respect to claims 29-35, in which the preamble is at issue, the Court of Appeals for the Federal Circuit ("Federal Circuit") clearly stated, in Eaton Corp. v. Rockwell International Corp., 66 USPQ2d 1271, 1276 (Fed. Cir. 2003), citing Pitney Bowes, Inc. v. Hewlett-Packard Co., 51 USPQ2d 1161, 1165 (Fed. Cir. 1999), that a claim preamble has the import that the claim as a whole suggests for it. In other words, when the claim drafter chooses to use both the preamble and the body to define the subject matter of the claimed invention, the invention so defined, and not some other, is the one the patent protects.

In this application, the claim preambles define tokens as tokens that point to another document, and the claim bodies provide the same definition by explicitly referring to "such tokens" or to "the user-selectable tokens."

Moreover, the Federal Circuit has stated in In re Cruciferous Sprout Litigation, 64 USPQ2d 1202, 1204 (Fed. Cir. 2002), that clear reliance on the preamble during the prosecution to distinguish the claims from the prior art may indicate that the preamble is a claim limitation because the preamble is used to define the claimed invention. The court went on to state that in the Cruciferous case, both the specification and the prosecution history indicates that a preamble phrase helped to define the claimed invention and, therefore, was a limitation of the patent.

In this application, the prosecution history includes Applicants' assertion that the preamble is a positively recited feature of the claims. Moreover, the specification itself supports this conclusion. In this regard, the statement on page 1 of the specification in the "Field of the Invention" section that ". . . the invention is directed to encoding areas of a paper document so that those areas may be scanned into a processing system in order to access additional documents, information, etc." should be noted (emphasis added).

With respect to the newly cited Federal Circuit case on page 2 of the Office Action, i.e., Storage Technology Corp. v. Cisco Systems, Inc., 66 USPQ2d 1545 (Federal Circuit 2003), the case is entirely inapposite to the facts of this application.

In Storage Technology, the district court based its interpretation in part on the presence of the phrase "policy caching method" or "policy cache" in the preamble of every independent claim of the '040 patent.

The Federal Circuit pointed out that whether to treat a preamble as a claim limitation is determined on the facts of each case in light of the claim as a whole and the invention

described in the patent. In the case of the '040 patent at issue, the Federal Circuit determined that the written description consistently uses the terms "policy caching method" and "policy cache" to refer to the invention as a whole, and not to the specific step of storing an instance of network policy or to the cache that stores the instance of network policy, which the written description refers to as the "instance policy cache." Similarly, the term "policy caching method" or "policy cache" in the preamble of each claim was found to serve as a convenient label for the invention as a whole. Thus, the preamble terms "policy caching method" or "policy cache" were held not to limit claim scope and simply refer to the invention set forth in the body of the claim, which, depending on the limitations provided in a particular claim, may include caching policy identification information or caching an instance of policy or both.

Claim 1 of the '040 patent included only the step of caching policy identification information, and therefore the Federal Circuit concluded that it was improper for the district court to further limit the scope of claim 1 based on language in the preamble.

The facts present in the "Storage Technology" case simply are not present in this application.

Moreover, the Federal Circuit also analyzed other claims in which it found that a preamble feature did limit the claims. The Office Action fails to address this aspect of the cited case and fails to apply the entire case to the facts of this application.

In pending claims 29 and 34, the language "such tokens" in the body refers back to the "tokens encoded in a document that point to another document" recited in the preamble. Thus, the preambles of claims 29 and 34 limit the meaning of "such tokens" in the bodies. In claim 32, the language "the user-selectable tokens" in the body refer back to the "user-selectable tokens encoded in a document that point to another document" recited in the

preamble. Thus, the preamble of claim 32 limits the meaning of "the user-selectable tokens" recited in the body.

Claims 36 and 37 positively recite tokens that point to another document in the claim body.

The Office Action then states, on page 2, with respect to the alleged teaching, suggestion or motivation to combine the references, that "[I]n this case, the knowledge would be generally available to one of ordinary skill in the art."

Unfortunately, the Office Action provides absolutely no evidence of this knowledge. A factual inquiry whether to modify a reference must be based on objective evidence of record, not merely conclusionary statements of the Examiner. See, In re Lee, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002). Thus, the alleged motivation for modifying the references to achieve the claimed invention appears to be improperly based on speculation and/or impermissible hindsight.

Lastly, the Response to Arguments section of the outstanding Office Action, page 2, adds yet another ground of rejection not mentioned in the previous rejection, which has been repeated and made final. This is improper.

Turning to the rejections, the Office Action rejects claims 29-35 under 35 U.S.C. §102(b) over U.S. Patent No. 5,905,246 to Fajkowski. This rejection is respectfully traversed.

The Office Action alleges that column 5, lines 51-62 of Fajkowski discloses a system for decoding tokens and using tokens encoded in a document "by means of a barcode embedded in a coupon." Applicants respectfully disagree.

Initially, Applicants note that the previous rejections of these claims under 35 USC §102(b) as anticipated by Fajkowski relied on column 3, lines 51-62. Because column 5,

lines 51-62 fails to disclose bar codes on coupons, and because column 3, lines 51-62 does disclose bar codes on coupons, Applicants will treat this part of the rejection as an obvious typographical error and consider the rejection to be based on column 3, lines 51-62 of Fajkowski.

Applicants define a "token" on page 2 of the specification, lines 10-13, as: (1) having two parts, the reference and the access information; and (2) "a pointer to a document, not a copy of a document." Claims 29-35 positively recite tokens that point to another document, a feature totally lacking in Fajkowski.

A prior art reference anticipates the subject of a claim when the reference discloses every feature of the claimed invention, either explicitly or inherently (see, In re Paulsen, 30 F.3d 1475, 1478, 1479, 31 USPQ2d 1671, 1675 (Fed. Cir. 1994), In re Spada, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990), Hazani v. Int'l Trade Comm'n, 126 F.3d 1473, 1477, 44 USPQ2d 1358, 1361 (Fed. Cir. 1997) and RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984)).

Because claims 29-35 recite a positively recited feature not disclosed by Fajkowski, i.e., the feature of "tokens encoded in a document that point to another document," Fajkowski does not anticipate claims 29-35. Accordingly, the rejection should be withdrawn.

The Office Action rejects claims 36, 37 and 39-45 under 35 U.S.C. §103(x) over U.S. Patent No. 5,486,686 to Zdybel in view of U.S. Patent No. 5,331,547 to Laszlo. This rejection is respectfully traversed.

Initially, Applicants note that this appears to be an obvious typographical error. Accordingly, Applicants will treat this rejection as based on 35 USC §103(a) instead of 35 USC §103(x).

The Office Action tacitly admits that Zdybel does not disclose a token that links one paper document to another paper document. To rectify this shortcoming in Zdybel, the Office Action relies on Laszlo, which is alleged to disclose a token that links a paper document to at least one other paper document, referencing column 4, lines 31-34, column 5, lines 66-68 and column 5, lines 1-4.

It is well settled that a rejection based on 35 U.S.C. 103 must rest on a factual basis, which the Patent and Trademark Office has the initial duty of supplying. In re GPAC, Inc., 57 F.3d 1573, 1582, 35 USPQ2d 1116, 1123 (Fed. Cir. 1995); In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one of ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. F-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note, In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). The mere fact that the prior art may be modified in the manner suggested by the examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992).

The first requirement is that a showing of a suggestion, teaching, or motivation to combine the prior art references is an “essential evidentiary component of an obviousness holding.” C.R. Bard, Inc. v. M3 Sys. Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232(Fed. Cir. 1998). This evidence may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved. See Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996). However, the suggestion more often comes from the teachings of the pertinent references. See In re Rouffet, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459(Fed. Cir. 1998). This showing must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not “evidence.” See In re Dembiczak, 175 F.3d 994 at 1000, 50 USPQ2d 1614 at 1617. However, the suggestion to combine need not be express and “may come from the prior art, as filtered through the knowledge of one skilled in the art.” Motorola, Inc. v. Interdigital Tech. Corp., 121 F.3d 1461, 1472, 43 USPQ2d 1481, 1489(Fed. Cir. 1997).

The Office Action provides absolutely no motivation to combine the applied references. All that the Office Action does is to provide speculation as to what would happen if the two references were combined, to wit: “[T]his modification basically expands the range of links for Zdybel's tokens.” This is not even a broad conclusionary statement concerning an alleged motivation to combine the references. It is simply a statement of what might happen if these two references are somehow combined. Moreover, the Office Action is completely silent as to how the teachings of Zdybel are to be modified in view of the teachings of Laszlo.

As is well settled, the factual basis of a Section 103 rejection must be interpreted without hindsight reconstruction of the invention from the prior art. In making this evaluation, the Examiner has the initial duty of supplying the factual basis for the rejection he

advances. He or she may not, because he or she doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. See, In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968).

As noted above, the Office Action states that "[I]n this case, the knowledge would be generally available to one of ordinary skill in the art."

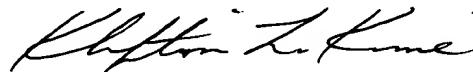
Also, as noted above, the Office Action provides absolutely no evidence of this knowledge. A factual inquiry whether to modify a reference must be based on objective evidence of record, not merely conclusionary statements of the Examiner. See, In re Lee, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002). Applicants respectfully submit that the only apparent reason for combining these references is based on speculation and/or on improper hindsight reconstruction of Applicants' invention based solely on Applicants' own disclosure.

Accordingly, because the Office Action fails to make out a prima facie case of obviousness of claims 36, 37 and 39-45, the rejection is improper and should be withdrawn.

Applicants respectfully submit that claims 29-37 and 39-45 are allowable and that the application is in condition for allowance. Favorable reconsideration and prompt allowance are earnestly solicited.

Should the Examiner believe that there is anything further that would place the application in even better condition for allowance, Applicants invite the Examiner to contact Examiner's undersigned representative at the telephone number listed below.

Respectfully submitted,



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Date: March 5, 2004

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